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REMARKS

Claims 1-4 and 16-23 are currently pending in the subject application and are presently under consideration. Applicants' representative thanks the Examiner for courtesies extended during telephone conference on September 7, 2004 regarding the subject application, wherein it was noted that the cited references fail to teach or suggest the subject claims as discussed below.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments below.

**I. Rejection of Claims 1-3, and 16-23 Under 35 U.S.C. § 103(a)**

Claims 1-3, and 16-23 stand rejected under 35 U.S.C. §103(a) as being obvious over Hudetz, *et al.* (U.S. Patent 5,978,773) in view of Dialog (article entitled Home Centers.) Withdrawal of this rejection is respectfully requested for at least the following reasons. Hudetz, *et al.*, alone or in combination with Dialog does not teach or suggest applicants' claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Contrary to the assertions made in the Office Action, the subject claims incorporate/operate via an electronic medium. For example, independent claim 1 recites "utilizing *data packet* information transferred to the manufacturer" (examples of such data packets are disclosed in applicants' specification at page 7 in a context of TCP/IP transmittals.) Likewise, independent claim 16 recites "transmitting demographic information [...] within the *web page request*"- which also necessitates an electronic medium. A similar limitation of "transmitting demographic information

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about the consumer to the product manufacturer *via* employing a Domain Name Service (DNS) to *translate Internet Protocol (IP)* mapping information transferred by the consumer when requesting *a web page*" is recited in independent claim 23. Thus, applicants' claimed invention, in part relates to providing *demographic information* about a consumer to a product manufacturer *via* an *electronic medium*.

Neither Hudetz, *et al.* nor Dialog, alone or in combination teach or suggest applicants' claimed invention, let alone there being no motivation to combine the reference as suggested. Hudetz is directed to a system for using identification codes found on ordinary articles of commerce to access remote computers on a network. Hudetz does not teach or suggest *transmitting demographic information* to the product manufacturer by utilizing an electronic medium as in applicants' claimed invention. Dialog fails to cure the aforementioned deficiencies of Hudetz, *et al.* with respect to the subject claims. Dialog, in the relevant section is directed to third party credit providers that supply ancillary marketing services to retailers- such is not providing demographic information by *utilizing data packet information transferred to the manufacturer as a result of the information inquiry*, or by utilizing information transferred *within the web page request*, as in applicants' claimed invention.

Moreover, the motivation asserted to combine the cited art in the manner suggested by the Office Action runs counter to the teachings of the cited art, since the purported combination defeats an intended function for activities required by retailers from the third party providers of Dialog. Dialog in part recites "*...the services the retailers want the most form the third party providers are cooperative advertising and promotional offers via mailing stuffers*", and teaches away from an *electronic medium*, which can for example be employed for transfer of data package information or web page request, as in applicants' claimed invention. (Teaching away from the art of the subject invention is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); A prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Hence, one of ordinary skill in the art would not have been motivated to modify/combine Hudetz, *et al.* and Dialog in a manner suggested by the Office Action – and even if the references are combined, applicants' claimed invention does not result. Accordingly, withdrawal of this rejection is respectfully requested.

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**II. Rejection of Claim 4 Under 35 U.S.C. § 103(a)**

Claim 4 stands rejected under 35 U.S.C. §103(a) as being obvious over Hudetz, *et al*, in view of Dialog, and further in view of Kaplan (U.S. Patent 5,963,916). Claim 4 depends from independent claim 1, and Kaplan does not make up for the aforementioned deficiencies of Hudetz, *et al*, in view of Dialog with respect to the subject independent claim. Accordingly, withdrawal of this rejection is respectfully requested.

**Conclusion**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731